

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

RALPH C. GRAY ET AL.

Serial No.: 09/858,280

Filed: May 16, 2001

For: CURABLE, WELDABLE
COATING COMPOSITION



PATENT APPLICATION

#4
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GROUP 1700

Group Art Unit: 1712

Examiner: R. E. SELLERS

Atty. Docket No.: 1656A1

RESPONSE TO RESTRICTION REQUIREMENT

Hon. Commissioner of Patents and Trademarks
Washington, DC 20231

Sir:

In an Office Action mailed on January 21, 2003, the Examiner has imposed a restriction requirement and is requiring the Applicants to make certain elections regarding the pending claims. The Applicants elect with traverse claims 1-15 which the Examiner says are "drawn to a composition comprising the reaction product of an epoxy polymer and a phosphorus acid groups-containing compound, a curing agent and an electroconductive pigment, classified in class 523, subclass 458."

In order to substantiate a proper restriction requirement of claims in an application, the Examiner must satisfy the following two requirements. First, the Examiner must show that the application claims independent or distinct inventions, as required by both §121 and the PTO rules. Second, the Examiner must show that examining all of the claimed inventions in a single application would constitute a serious burden. M.P.E.P. § 803.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231	
on <u>February 20, 2003</u>	<u>Maria Edwards</u>
Date	Signature
<u>Maria Edwards</u>	
Typed or Printed Name of Person Signing Certificate	

The Applicants are electing claims 1-15 with traverse because the Examiner has not shown that examining all of the claimed inventions in a single application would constitute a serious burden in this instance. Claims 1-15 are drawn to a generic coating composition covering both aqueous coating compositions and organic solvent-based coating compositions. In the present application, an aqueous coating composition is claimed in claims 16-20 and an organic solvent-based coating composition is claimed in claims 21-24. When examining generic claims 1-15, the Examiner's search will out of necessity encompass references directed to aqueous coating compositions and references directed to organic solvent-based coating compositions. Therefore, it would not be a serious burden for the Examiner to examine claims 1-24 in a single application. The Applicants are willing to cancel claims 24-28, if necessary, to avoid the restriction requirement.

In the Office Action, the Examiner is also requiring the Applicants to elect a single disclosed species for the following:

- 1) The epoxy resins such as the polyglycidyl ether of bisphenol A defined in claim 3;
- 2) The phosphorus acid groups-containing compounds such as either the phosphoric acid, phosphonic acid or phosphorous acid of claim 5;
- 3) The curing agent a.ii. such as the aminoplast of claim 9;
- 4) The electroconductive pigments such as either the zinc, aluminum, iron, graphite, diiron phosphide, tungsten or stainless steel of claim 10;
- 5) The presence or absence of the potassium tripolyphosphate of claim 18;
- 6) The presence or absence of the amine of claim 19; and
- 7) The presence or absence of the corrosion inhibiting pigments of claim 20.

In order to substantiate an election of species requirement, the Examiner must satisfy similar requirements to those stated above. Because the Examiner has not shown that examining all of the claimed species would constitute a serious burden in this instance, the Applicants elect the following with traverse:

- 1) For the epoxy resins, the Applicants elect with traverse the polyglycidyl ether of bisphenol A as defined in claim 3;
- 2) For the phosphorus acid groups-containing compounds, the Applicants elect with traverse the phosphoric acid of claim 5;
- 3) For the curing agent, the Applicants elect with traverse the aminoplast of claim 9;
- 4) For the electroconductive pigments, the Applicants elect with traverse iron phosphide as described at page 11, lines 2-4;
- 5) The Applicants elect with traverse the absence of the potassium tripolyphosphate of claim 18;
- 6) The Applicants elect the absence of the amine of claim 19 with traverse; and
- 7) The Applicants elect with traverse the absence of the corrosion inhibiting pigments of claim 20.

Because this Response fully complies with all of the requirements set forth in the Office Action, the prosecution of this case should move forward. If any issues remain or you have further questions, please give me a call at 412-434-2938. Thank you.

Respectfully Submitted,

Jacques B. Miles

Jacques B. Miles
Attorney for Applicant
Registration No.: 42,888

Pittsburgh, Pennsylvania
February 20, 2003

1712

AMENDMENT TRANSMITTAL LETTER (Large Entity)		Docket No.
Applicant(s): Ralph C. Gray et al.		1656A1

Serial No. 09/858, 280	Filing Date May 16, 2001	Examiner R. E Sellers	Group Art Unit 1712
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Invention: **CURABLE, WELDABLE COATING COMPOSITIONS**

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TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith is an amendment in the above-identified application.

The fee has been calculated and is transmitted as shown below.

CLAIMS AS AMENDED						
	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST # PREV. PAID FOR	NUMBER EXTRA CLAIMS PRESENT	RATE	ADDITIONAL FEE	
TOTAL CLAIMS	28 -	28 =	0 x	\$18.00	\$0.00	
INDEP. CLAIMS	5 -	5 =	0 x	\$84.00	\$0.00	
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					\$0.00	
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT					\$0.00	

- ☒ No additional fee is required for amendment.
- ☒ Please charge Deposit Account No. **16-2025** in the amount of
A duplicate copy of this sheet is enclosed.
- ☐ A check in the amount of _____ to cover the filing fee is enclosed.
- ☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. **16-2025**
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 - ☒ Any additional filing fees required under 37 C.F.R. 1.16.
 - ☒ Any patent application processing fees under 37 CFR 1.17.

Jacques B. Miles
Signature

Dated: **February 20, 2003**

Jacques B. Miles,
Attorney for Applicant
Registration No.: **42,888**

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I certify that this document and fee is being deposited on **Feb. 20, 2003** with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

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